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| EXAMINER |
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3629

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/684,010

Applicant(s)

SMITH ET AL.

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
  - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The numbering of claims is not in accordance with 37 CFR § 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).
  - 2.1 Misnumbered claims 20-31 have been renumbered as 19-30 respectively.
3. The use of various trademark(s), for example "iShip.com", "iShip", "The Internet Package shipper", "Price It", "Sell It", "Track It", "Ship It", "Track It", "Ship It", "Shipping Tools", "My iShip", "Netscape's Navigator™", "Microsoft Internet Explorer™", in the paragraph:
  - A) between pages 11, line 28, and page 12, line 2, "'iShip.com', 'iShip', 'The Internet Package shipper', 'Price It', 'Sell It', 'Track It', 'Ship It', 'Track It', 'Ship It', 'Shipping Tools', 'My iShip' and ...of their respective owners.'";
  - B) at page 15, lines 20-25, "Users access 1003 ... web browsers include, e.g. Netscape's Navigator™ and Microsoft Internet Explorer™."; and
  - C) between page 16, line 39, and page 17, line 2, "As depicted in FIG. 5, using ... 'iShip.com' ...particular Carrier's web server.'";have been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.
- 3.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The drawings are objected to because

A) the following errors have been noted in the drawings:

(1) since figs. 10a, 10b, 10c, 10d & 10e are five separate drawings that combined form a single flowchart, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --10A--, --10B--, --10C--, --10D--, & --10E--.

(2) since figs. 27a, 27b & 27c are three separate drawings that combined form a single flowchart, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --27A--, --27B--, & --27C--.

(3) since figs. 33a & 33b are two separate drawings that combined form a single diagram, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --33A-- & --33B--.

(4) since figs. 36c & 36d are two separate drawings that combined form a single flowchart, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --36C-- & --36D--.

(5) since figs. 37a & 37b are two separate drawings that combined form a single diagram, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --37A-- & --37B--.

(6) since figs. 39a, 39b & 39c are three separate drawings that combined form a single flowchart, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --39A--, --39B--, & --39C--.

(7) since figs. 64a-1 & 64a-2 are two separate drawings that combined form a single diagram, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --64A-1-- & --64a-2--.

(8) since figs. 64b-1 & 64b-2 are two separate drawings that combined form a single diagram, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --64B-1-- & --64B-2--.

(9) since figs. 65a & 65b are two separate drawings that combined form a single diagram, as required by 37 C.F.R. § 1.84(u)(1) these figures must be labeled as --65A-- & --65B--.

(10) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description, see the reference numbers designated below in section (5)(A)(1) of the objection to the disclosure.

(11) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description, for example reference number:

(a) 1071 of fig. 36a as disclosed in the paragraph at page 46, line 1-8, "At the intersection ... element 1071 ... for which that cell represents the intersection."

(12) as can be seen in fig. 54 and from the context of the paragraph at page 74, lines 9-15, "In creating the display ... browser 258 display device DPI is 96.", it appears from the text contained in box 1256 that either the "YES" and "NO" legends or reference numbers 1257 & 1257 are reversed.

4.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

5. The disclosure is objected to because of the following informalities:

A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 9n, 11n, 12n, 13n, 21a, 1003a, 1003b, 1003c, 1003d, 1024n & 1027n of fig. 7 as this figure is being described in the paragraphs between page 17, line 28, and page 19, line 1, "FIG. 7 is a simplified ...which is described in detail below.";

(b) 122, 123a, 123b & 124 of fig. 13 as this figure is described in the paragraph between page 23, line 22, and page 24, line 4, "If the data entered ... below with regard to FIG. 26.";

(c) 42 of fig. 10A as this figure is described in the paragraphs between page 21, line 25, and page 25, line 8, "FIGS 10a through 10e ... setup selling preferences for eCommerce transactions.";

(d) 80 of fig. 10c as this figure is described in the paragraphs between page 44, line 2, and page 45, line 4, "As depicted in FIG. 34, ... as depicted in FIG. 10c).";

(e) 62 & 80 of fig. 10d as this figure is being described (note the objection to the labeling of figs. 10a-10e, below);

(f) 80 of fig. 10e as this figure is being described (note the objection to the labeling of figs. 10a-10e, below);

(g) 163a, 163b, 163c, 163d, 163e, 165a, 165b, 165c, 165d, 165e, 165f, 165g, 167a & 167b of fig. 19 as this figure is described between page 25, line 24, and page 26, line 4, "FIG. 19 is a ... the selection button e.g., 160.";

(h) 178 of fig. 21 as this figure is described in the paragraphs at page 26, lines 8-28, "If the User clicks the Next button 102 ... User so that the User can process the information 180.";

(i) 238 of fig. 23 as this fig. is described in the paragraph between page 27, line 19, and page 28, line 3, "As depicted in FIG. 23 ... preferences have been saved 239.";

(j) 31b-4 of fig. 24 as this figure is described in the paragraph at page 28, lines 17-27, "Fig. 24 is a ... of a Create a Seller's Link Screen 52.";

(k) 204 of fig. 25 as this figure is describe between page 28, line 23, and page 29, line 2, "Once the User has completed ... is asked to enter the Shipping Weight 191a.";

(l) 612 of fig. 27a as this figure is described in the paragraphs between page 31, line 14, and page 34, line 2, "In order to identify ... that the weight is not stable 624.";

(m) 1032-1, 1032-2, 1032-3, 1032-4, 1032-5, 1032-6, 1032-7, 1077, 1078, 1101a, 1101b, 1140, 1141, 1142 & 1142a of fig. 28 as this figure is being described in the paragraphs between page 35, line 3, and page 39, line 8, FIG. 28 depicts ... as described above with regard to FIGS. 15 and 26).";

(n) 216 & 217 of fig. 30 as this figure is described in the paragraphs between page 39, line 17, and page 40, line 29, "FIG. 30 depicts ... Seller's eCommerce/eAuction item description.";

(o) 214 of figs. 31 & 32 as these figures are described in the paragraphs between page 40, line 12, and page 42, line 7, "In order to create ... PID and its associated set of information.";

(p) 251-2, 251-4, 252-1, 252-2, 252-3, 252-4, 253-1, 253-2, 253-4, 255-1, 255-2, 255-3, 255-4, 256-1, 256-3, 257-2, 257-3, 257-4, 257-5, 257-6, 257-7, 258-2, 258-3, 258-4, 270-1, 270-2 & 270-3 of figs. 33a & 33b as these figures are described in the paragraphs between page 42, line 8, and page 43, line 18, "FIGS. 33a and 33b ... Account User Configuration table 253.";

(q) 1140, 1141, 1142, 1143 of fig. 36a as this figure is described in the paragraphs between page 45, line 9, and page 51, line 28, "FIG. 36a depicts an ... the Shipping Location field 1066.";

(r) 1152 of fig. 39a as this figure is described in the paragraph at page 60, lines 4-8, In the embodiment depicted ... further Shipper Parcel Specifications 1150.";

(s) 1192 of fig. 36c as this figure is described in the paragraphs between page 62, line 19 and page 64, line 2, "Next 1170, the system ... in the delivery rate set 1157.";

(t) 359 of fig. 42 as this figure is described in the paragraphs at page 67, lines 7-21, "FIG. 42 is a ... Tracking section of the disclosure of the present invention.";

(u) 373 of fig. 43 as this figure is described in the paragraphs between page 67, line 22, and page 68, line 9, "FIG. 43 is a ...10d) in the Buyer Response process.";

(v) 431-1 of fig. 47 as this figure is being described in the paragraphs between page 70, line 28, and page 71, line 13, "In an eCommerce embodiment ... 418 to send the payment information to processing.";

(w) 1111 of fig. 48 as this figure is described in the paragraph at page 71, lines 14-27, "In an exemplary simplified Internet ... Expiration Date, and Credit Card Type.";

(x) 426 of fig 51 as this figure is described in the paragraph at page 72, lines 11-19, "In an exemplary eCommerce ... shipped by the particular Shipper/Seller.";

(y) 32b-4, 32b-5, 32b-6 & 32b-7 of fig. 50 as this figure is described in the paragraph between page 72, lone 20, and page 73, line 3, "The Seller can view ... shipment 445, or reprint a label 446.";

(z) 1258 of fig. 54 as this figure is described in the paragraph at page 74, lines 9-15, "In creating the display ... browser 258 display device DPI is 96.";

(aa) 2050 & 2051 of fig. 69 as this figure is described in the paragraphs between page 84, line 15, and page 86, line 20, "FIG. 69 is a logic flow ... as described above regarding Package Table 28 records.";

(ab) 2081, 2090 & 2097 of fig. 72 as this figure is described in the paragraphs between page 87, line 26, and page 93, line 18, "As depicted in FIG. 72, if ... for the packages that are shipped using the CMS.";



(ac) 2101 of fig. 73 as this figure is described in the paragraph at page 93, lines 19-22, "FIG 73 is a graphic ... clicking on the "Track" button 2102.";

(ad) 2120 & 2123 of fig. 77 as this figure is described in the paragraphs between page 94, line 17, and page 95, line 11X, "FIG. 77 is a graphic ... record in the list and clicks the "Details" button 22124.";

(ae) 2164 & 2166 of fig. 80 as this figure is described in the paragraph between page 95, line 26, and page 96, line 9, "A registered logged on User ... for that User on Inbound Packages to be monitored.";  
and

(af) 2123 of fig. 81 as this figure is described in the paragraph at page 96, lines 10-22, "Once the User has input ... line on the screen and clicking the "Delete" button 2170."; and

(2) how the program proceeds after box(es):

(a) 620 of fig. 27B if the inquiry is "NO" in the paragraphs between page 31, line 14, and page 34, line 2, "In order to identify ... that the weight is not stable 624.";

(b) 3026 of fig. 36c as this figure is described in the paragraph at page 56, lines 3-17, "As depicted in Figures 36c through 36d, ... to different parties for various billing options).";

(c) 3042 & 344 of fig. 36e if the inquiry is either "YES" or "NO" as this figure is described in the paragraph at page 56, lines 18-25, "As depicted in FIG. 36e ... to a particular Carrier/Service 3044.";

(d) 1163, 1168, 1169, 1172 & 1175 of fig. 39b if the inquiry is "NO" as this figure is described in the paragraphs between page 61, line 1, and page 62, line 24, "Using the Expected Shipping Date ... Carrier/Service in the delivery rate set 1157.";

(e) 1180, 1184, 1187 & 1190 of fig. 36c if the inquiry is "NO" as this figure is described in the paragraphs between page 62, line 19 and

page 64, line 2, "Next 1170, the system ... in the delivery rate set 1157.";

(f) 1192 of fig. 36c if the inquiry is either "YES" or "NO" as this figure is described in the paragraphs between page 62, line 19 and page 64, line 2, "Next 1170, the system ... in the delivery rate set 1157."; and

(g) 2050 of fig. 69 if the inquiry is "Fail" as this figure is described in the paragraphs between page 84, line 15, and page 86, line 20, "FIG. 69 is a logic flow ... as described above regarding Package Table 28 records.".

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

B) the following errors have been noted in the specification:

1) as can be seen in figs. 10a, 10b, 10c, 10d & 10e and from the paragraph(s):

(a) in the brief description of figs. 10a, 10b, 10c, 10d & 10e at page 4, lines 16-18, "FIGS. 10a through 10e are ... system eCommerece environment.";

(b) page 11, lines 18-25, "A portion of the disclosure ... FIGS 10a through 10e, ... reserves all copyright whatsoever.";

(c) between page 21, line 25, and page 28, line 27, "FIGS 10a through 10e ... a Create a Seller's Link Screen 52.";

(d) between page 44, line 2, and page 45, line 4, "As depicted in FIG. 34, ... as depicted in FIG. 10c).";

(e) at page 58, lines 2-8, "Whether or not the Buyer/Seller ... the purchase and shipping of the item.";

(f) between page 66, line 17, and page 68, line 18, "FIG. 41 is a ... Buyer Shipping Information Collection screen (61, FIG. 10d).";

(g) between page 70, line 28, and page 73, line 14, "In an eCommerce embodiment ... the Seller and as finally selected by the Buyer."; and

(h) between page 77, line 14, and page 78, line 14, "Returning to the exemplary ... can be delivered via the carrier (74, FIG. 10e).";  
each reference to figs. "10a", "10b", "10c", "10d" & "10e" in these paragraphs should be either -10A--, --10B--, --10C--, --10D--, & --10E-- respectively as required by 37 C.F.R. § 1.84(u)(1).

(2) as can be seen in figs. 27a, 27b & 27c and from the paragraph(s):

(a) in the brief description of figs. 27a, 27b & 27c at page 6, lines 5-7, "FIGS. 27a through 27c are ... System in an Internet environment."; and

(b) between page 31, line 14, and page 34, line 2, "In order to identify ... that the weight is not stable 624.";  
each reference to figs. "27a", "27b" & "27c", in these paragraphs should be -27A--, --27B--, and -27C--, respectively as required by 37 C.F.R. § 1.84(u)(1).

(3) as can be seen in figs. 33a & 33b and from the paragraph(s):

(a) in the brief description of figs. 33a & 33b at page 6, lines 23-26, "FIGS. 33a and 33b are ... system eCommerce environment.";

(b) page 42, lines 8-17, "FIGS. 33a and 33b ... Site table 260, and Site table 270."; and

(c) at page 80, lines 11-25, "FIGS 65a and 65b represent a ... Bill contact name 26-15, and Bill address 1 261-16.";  
each reference to figs. "33a" & "33b", in these paragraphs should be -33A-- & -33B--, respectively as required by 37 C.F.R. § 1.84(u)(1).

(4) as can be seen in figs. 36c & 36d and from the paragraph(s):

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(a) in the brief description of figs. 36b, 36c, 36d & 36e at page 7, lines 7-8, "FIGS. 36b through 36e are ... uses to calculate a shipping rate."; and

(b) between page 55, line 10, and page 56, line 35, "FIGS 36b through 36e ... to the particular Carrier/Service 3044."; each reference to figs. "36c" & "36d", in these paragraphs should be --36C-- & --36C-- as required by 37 C.F.R. § 1.84(u)(1).

(5) as can be seen in figs. 37a & 37b and from the paragraph(s):

(a) in the brief description of figs. 37a & 37b at page 7, lines 12-15, "FIGS. 37a and 37b are ... system eCommerce environment."; and

(b) between page 56, line 26, and page 58, line 1, "In an eCommerce embodiment ... on the display monitor of the Buyer's computer 8-2."; each reference to figs. "37a" & "37b", should be --37A-- & --37B-- as required by 37 C.F.R. § 1.84(u)(1).

(6) as can be seen in figs. 39a, 39b & 39c and from the paragraph(s):

(a) in the brief description of figs. 39a, 39b & 39c at page 7, lines 19-22, "FIGS. 39a through 39c are ... System in an Internet environment."; and

(b) between page 59, line 15, and page 64, line 19, "FIGS 39a through 39C are ... are performed by one or more of the NOC Servers 20a-21z."; and

(c) between page 65, line 28, and page 66, line 4, "It should be noted that, ... relation to FIGS 39a through 39c."; and

(d) at page 70, lines 19-27, "Once the Shipper selects ... and information for the Selected Carrier."; each reference to figs. "39a", "39b" & "39c", should be --39A--, --39B-- & --39C-- as required by 37 C.F.R. § 1.84(u)(1).

(7) as can be seen in figs. 64a-1, 64a-2, 64b-1 & 64b-2 and from the paragraph(s):

(a) in the brief description of figs. 64a-1, 64a-2, 64b-1 & 64b-2 at page 9, lines 27-30, "FIGS. 64a-1, 64a-2, 64b-1 and 64b-2 are ... system eCommerce environment."; and

(b) between page 78, line 21, and page 80, line 10, "FIGS. 64a-1, 64a-2, 64b-1 and 64b-2 ... displays the Shipping screen to the Seller 530.";

each reference to figs. "64a-1", "64a-2", "64b-1" & "64b-2", should be --64A-1--, --64A-2--, --64B-1-- & --64B-2-- as required by 37 C.F.R. § 1.84(u)(1).

(8) as can be seen in figs. 65a & 65b and from the paragraph(s):

(a) in the brief description of figs. 65a & 65b at page 10, lines 1-15, "FIGS. 65a and 65b represent ... system eCommerce environment."; and

(b) at page 80, lines 11-25, "FIGS 65a and 65b represent a ... Bill contact name 26-15, and Bill address 1 261-16.";

each reference to figs. "65a" & "65b", should be --65A-- & --65B-- as required by 37 C.F.R. § 1.84(u)(1).

(9) as can be seen in fig. 27a and from the context of the paragraph at page 32, lines 14-21, "Continuing with FIGS 27a through 27c, ... interface 613. Otherwise, the user may input the weight 613 in the Weight field 1051 as depicted in e.g., FIG. 26", at line 7 of this paragraph "weight 613" should be --weight 612--.

(10) as can be seen in fig. 28 and from the context of the disclosure at page 37, lines 9-14, Sorted, valid delivery times ... buttons 1100a and 1100b respectively. If an up or down button (1100a and 1100b respectively) ... Array display area 1096.", at lines 2 & 3 of this paragraph "1100a and 1100b" should be --1101a and 1101b--.

(11) the description of figs. 33a & 33b in the paragraphs between page 42, line 8, and page 43, line 18, "FIGS. 33a and 33b ... Account User Configuration table 253.", does not correspond to what is depicted in these figs.

(12) the description of figs. 36c & 36d in the paragraph at page 56, lines 3-17, "As depicted in Figures 36c through 36d, ... to different parties for various billing options).", does not correspond to what is depicted in these figs. in regard to step 3026, since at one point the "YES" and "NO" legends appear to be mislabeled, note lines 2-3 of this paragraph and lines 8-10 of this paragraph.

(13) as can be seen in fig. 39a, and from the context of the paragraph at page 60, lines 4-8, "In the embodiment depicted ... messages 153 ... further Shipper Parcel Specifications 1150.", at line 5 of this paragraph "153" should be -1153--.

(14) as can be seen in fig. 54 and from the context of the paragraph at page 74, lines 9-15, "In creating the display ... browser 258 display device DPI is 96.", at line 7 of this paragraph "258" should be -1258--.

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

7. Claims 8 & 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1 Claim 8 in regard to the 4th server system, since claim 2 does not have a 2<sup>nd</sup> or 3<sup>rd</sup> server system.

7.2 In regard to renumbered claim 19, since the instant application as originally filed lacks a claim 19, it is unclear from which claim renumbered claim 19 should depend.

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7.3 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

8. Claims 1-30 are provisionally rejected under the judicially created doctrine of double patenting over

- A) claims 1-72 of copending Application No. 09/680,649; or
- B) claims 1-89 of copending Application No. 09/680,654; or
- C) claims 1-6 of copending Application No. 09/684,014; or
- D) claims 1-9 of copending Application No. 09/684,861; or
- E) claims 1-21 of copending Application No. 09/684,865; or
- F) claims 1-53 of copending Application No. 09/684,866; or
- G) claims 1-63 of copending Application No. 09/684,869; or
- H) claims 1-57 of copending Application No. 09/685,077; or
- I) claims 1-58 of copending Application No. 09/685,078.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

8.1 The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

- A) in a computer network system comprising a central computer/server connected to a number of user/client computers and configured/programmed to provide various interactive shipping services, such as rating, rate comparison and tracking for multiple carriers to the users in response to the requests of users sent to the server from the client computers via the network.

It is noted that the information, whether it is shipping rate data, rate comparison data, tracking data, etc. or how the requested information is displayed to the user does not affect the operation of the basic system as recited in each of the identified application, hence the type of information/data is considered to be non-functional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been

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obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

8.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

8.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --



(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9.1 Claims 1-30 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258).

9.2 Claims 1-30 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983).

9.3.1 In regard to claim 20, since this claim repeats subject matter recited in other claims, when those claims are mentioned, then claim 20 has been addressed.

9.3.2 In regard to claims 1-30, TULSA or TEMPE or Barton ('983) discloses an internet based shipping system that comprises properly programmed server and client systems to accept rating related information from users and then return to the user from the server the shipping rate for a number of different carriers. Further, the TULSA system permits the user track the item being shipped.

9.3.3 In regard to claims 1-30, Thiel ('258) discloses a networked based shipping system that comprises properly programmed central computer/server and client shipping systems to accept rating related information from users and then return to the user from the server the shipping rate for a number of different carriers. Further, the Thiel ('258) system permits the user track the item being shipped. Further, since:

A) the internet is a communications network as is the wireless network of Thiel ('258), and

B) the claims fail to recite sufficient structure so as to distinguish a particular type of communications network,

one of ordinary skill at the time the invention would recognize the two separate types of networks as functionally equivalent. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

10. In regard to the Information Disclosure Statement filed June 05, 2002, it is noted that the 15 U.S. Patent Applications listed were not publicly known on October 06, 2000, therefore these applications have been considered for the purposes of double patenting.

11. The examiner has cited prior art of interest, for example:

A) either Picione (4,495,581) or Barns-Slavin et al (5,117,364) or Solondz et al (5,602,742) disclose rating an item to be shipped for number of different classes and carriers based on user input values in order to determine the lowest shipping rate.

B) Nomura (JP 05-276353) discloses charging the end user for service provided over a network.

C) either Levitsky et al (6,466,948) or Carroll et al (6,470,327) disclose rating an item to be shipped for number of different classes and carriers based on user input values.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

13.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

13.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

10/15/03



Edward R. Cosimano  
Primary Examiner A.U. 3629